

REMARKS/ARGUMENTS

Currently in the case, after amendment, claims 21 & 24 - 34 are pending and believed to be in condition for allowance.

This Amendment responds to the aforementioned Office Action, wherein the claims as originally presented were rejected under Title 35 of United States Code, as to the specification and §§ 102 & 103. The Examiner's remarks have been carefully considered and, in view of the cited art, the claims which have amended to more particularly point out the distinctly claimed what Applicants regard as the subject matter of this present invention, it is sincerely believed that the claims which remain in the instant case patentably distinguish over all the prior art references. It is respectfully requested that this Application be re-examined in view of the following remarks, that the rejections be withdrawn, and that allowable subject matter be identified.

The points raised by the Examiner in the written office action will be responded to in the order they were discussed by the Examiner in the Office Action.

Attorney for applicant notes the acceptance of the drawings, and the receipt by the PTO of all of the certified priority documents.

On the cover sheet, and in numbered paragraph 1, the disclosure was objected to because of the letter "a" appearing next to the combination "figure 3". This objection is believed to have been overcome by a short amendment of the specification.

\$102 Rejections

At numbered paragraphs 2 and 3, the Examiner rejected claims 21, 23-25 (only claims 24-25 remain in this group) and claim 27 as anticipated by U.S. Patent Publication No. US 2005/0021172 entitled "METHOD AND APPARATUS FOR PREPARING MEDIA" to Winter et al, and which relates to alignment and positioning with respect to a work tool.

Claim 21 has been amended to make the meaning more clear and to illustrate its allowability over Winter et al. According to claim 21, the following comparison of configurations of the present invention and cited document can be readily seen.

The examiner says that Winter et al teaches all subject matter claimed as applied above. The Examiner characterizes Winter et al as fitting within the claim elements of claim 21 before amendment. Even an overly liberal characterization of the teaching of Winter, when combined with the further limitation of claim 21 as amended, renders claim 21 as patentable over the cited reference. Claim 21 has been amended to add the limitations that (1) the IC-tag tape is positioned between said

corrugated medium and said second linerboard, (2) wherein the interface between said IC-tag tape and said second linerboard forms an unconnected area, and (3) wherein said unconnected area has a width that does not reduce the compressive strength of the cut sheet formed from said corrugated board.

The Examiner also rejected independent claim 24, but blended the basis into the basis of rejection of remaining claims 21. It should be noted that according to claim 24, (a) Comparison of configurations of the present invention and cited document can be seen. The applicant amends to add "wherein said cut sheet includes a plurality of layers, and wherein said IC-tag tape is positioned and attached between said plurality of layers using neither bonding material nor adhesive material." to claim 24 (See paragraph [0036] in specification). Thus, the amended claim 24 is obviously different from the techniques described in the cited document (US 2005/0021172).

In terms of the advantageous effect of the present invention and as to claim 24, and as the inventions in amended claims 24 comprise these configurations, it is clear that the IC-tag tape is positioned and attached between the plurality of layers without using bonding material and without using adhesive material, which cannot be easily imagined from the cited document (US 2005/0021172), both because it is simply not present in a §102 sense, and also in a §103 sense because it cannot be

imagined at all from the cited document by one of ordinary skill in the art.

Accordingly, the inventions according to amended claims 24 and following are patentable. Therefore, the claims 25-27, which depend on the amended claim 24, are also believed to be patentably allowable.

§103 Rejections

Closely aligned with the rejections of paragraphs 2 and 3 of the office action, and at numbered paragraphs 4 and 5, the Examiner rejected claims 22, 26 and 28 - 34 as being unpatentable over the same U.S. Patent Publication No. US 2005/0021172 to Winter et al., but now with regard to 35 U.S.C. § 103 obviousness. In this regard, the Examiner states that it is "obvious to supply a sheet that is made of corrugated board since it is just a matter of using different sheet of different material for the IC-tag to be taped on". The Examiner goes on to identify aspects of claims 26 and 28 - 33 as being supplied by Winter et al.

As such, the Examiner goes on to state that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Winter to provide the sheet that is made of corrugated board since it is just a

matter of using different sheet of different material for the IC-tag to be taped on."

However, the aforementioned three amendments to the claim are further believed to take the claim out of any possibility of both rejections under 35 U.S.C. §102 or §103. The applicant amends to add "wherein the cut sheet is made of a corrugated board comprising a second linerboard (8) a first linerboard (9) that forms the opposite side of said cut sheet with respect to said second linerboard. and a corrugated medium (10) that is positioned between said second linerboard and said first linerboard", which is the configuration of claim 22, to claim 21. Furthermore, the applicant adds "wherein said IC-tag tape is positioned between said corrugated medium and said second linerboard, wherein the interface between said IC-tag tape and said second linerboard forms an unconnected area, and wherein said unconnected area has a width that does not reduce the compressive strength of the cut sheet formed from said corrugated board" "to claim 21 (See paragraph [0036] in the specification). Thus, the amended claims 21 is obviously different from the techniques described in the cited document (US 2005/0021172), because the position in which the IC-tag tape is arranged becomes clear.

Advantageous effect of the present invention (taken both with respect to 35 U.S.C. 102 or 103).

As the inventions in amended claims 21 comprise these configurations, IC-tag tape is inserted between a single-face flute and a linerboard. Accordingly, the IC tag tape is held between the single-face flute and the linerboard and firmly fixed in a predetermined position. Furthermore, as the IC tags are positioned inside the second linerboard, it is also possible to prevent the IC tags from being damaged even if the cut sheet becomes worn because of the friction between the cut sheets during the shipment. Thus, the amended claim 21 has inventive steps.

Accordingly, the inventions according to amended claims 21 are patentable over the cited reference with respect to both 35 U.S.C. §102 and §103. Therefore, the claims 28-34, which depend on the amended claim 21, are also patentable.

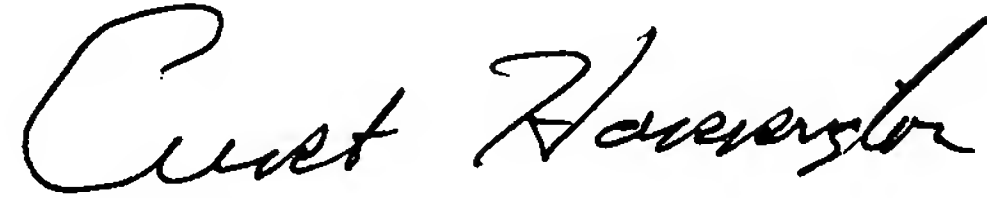
The reasoning for this amendment having been explained, it is believed that claims 21 & 24 -34 are currently in condition for allowance, and an indication of such is respectfully solicited.

The Examiner is invited to telephone Applicant's Attorney at the number below between the hours of 1:00 p.m. and 6:00 p.m. Eastern Standard Time, if such will advance this case. The Examiner is urged to call for any matter and Attorney for

Applicant looks forward to having telephonic contact to help resolve any issues which remain in this case.

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